



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,485	12/06/2001	Kevin P. Baker	GNE.2830P1C9	3503

7590 06/24/2004  
Ginger R. Dreger  
Knobbe Martens Olson & Bear  
Sixteenth Floor  
620 Newport Center Drive  
Newport Beach, CA 92660

EXAMINER

KAPUST, RACHEL B

ART UNIT PAPER NUMBER

1647

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/006,485	BAKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rachel B. Kapust	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004 and 19 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 28-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **RESPONSE TO AMENDMENT**

Applicant's amendment filed April 7, 2004 and supplemental amendment filed May 19, 2004 are acknowledged. Claim 37 has been canceled. Claims 28-36 are amended. Claims 28-36 and 38-40 are pending and under consideration. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

The declaration filed on April 7, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the *Lal et al.* (WO 00/00610) reference. A declaration filed under 37 CFR 1.131 must be signed by all of the inventors of the subject matter of the rejected claims. The declaration filed on April 7, 2004 was only signed by Luc Desnoyers.

### ***Claim Rejections/Objections Withdrawn***

The rejection of claims 28-33, 39, and 40 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in response to Applicants' amendment to the claims removing the limitation that the encoded protein comprise an "extracellular domain...lacking its associated signal peptide." The rejection of claim 37 is withdrawn in response to Applicants' cancellation of claim 37.

The rejection of claims 28-32, 39, and 40 under 35 U.S.C. 112, first paragraph, for lack of enablement, is withdrawn in response to Applicants' amendments to the claims reciting a functional limitation for the claimed polypeptides.

The rejection of claims 28-32, 39, and 40 under 35 U.S.C. 112, first paragraph, for lack of written description is withdrawn in response to Applicants' amendments to the claims reciting a functional limitation for the claimed polypeptides.

The rejection of claim 43 under 35 U.S.C. 112, first paragraph, for lack of written description is withdrawn in response to Applicants' amendment to claim 41, upon which claim 43 is dependent.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-36 and 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drawn to isolated polypeptides "capable" of inducing chondrocyte proliferation. By saying that the polypeptides are "capable" of inducing chondrocyte proliferation, Applicants imply that there would be conditions under which the polypeptides would not induce chondrocyte proliferation. If the claims were meant to encompass conditions under which the polypeptides did not induce chondrocyte proliferation, one of skill in the art would not know how to use the claimed polypeptides under such conditions. The rejection could be obviated by amending the claims so that they are drawn to isolated polypeptides wherein the "polypeptide induces chondrocyte proliferation".

***Claim Rejections - 35 USC § 102***

The rejection of claims 28-32, 39, and 40 under 35 U.S.C. 102(a) as being anticipated by Lal *et al.* (WO 00/00610) is maintained for reasons of record on p. 6 of the previous office action. As stated above, the declaration submitted on April 7, 2004 is ineffective because it was not signed by all of the inventors of the rejected claims. Thus, the declaration cannot be considered as evidence. WO 00/00610 teaches SEQ ID NO: 24, which encodes a polypeptide that is 99.3% identical to SEQ ID NO: 140. Claims 28-32 and 41-47 are anticipated by WO 00/00610.

***Conclusion***

NO CLAIMS ARE ALLOWED.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel B. Kapust whose telephone number is (571) 272-0886. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RBK  
6/22/04

  
JANET ANDRES  
PATENT EXAMINER